

REMARKS

The pending Office Action addresses claims 1, 3-9, and 11-24, rejecting all of the claims. By this response, claims 1, 3, 9, 17, and 21-24 are amended, claim 25 is added, and claim 5 is canceled. Reconsideration and allowance are requested in light of the amendments and the following remarks.

In particular, Applicants amend claims 1, 17, and 21-24 to clarify that the maneuverable apparatus includes a flexible *tubular* elongate member, a *tubular* deflection member that is *coaxial* with the elongate member, and a conductor. Support for these amendments can be found throughout the specification, for example, at page 15, line 19 (flexible tubular elongate member), page 17, lines 9-16 and original claim 5 (tubular deflection member that is coaxial with the elongate member), as well as on pages 4-5 (device in general).

Applicants also amend claims 1, 17, and 21-24 to clarify the position of the conductor. Support for this amendment can be found throughout the specification, for example, at page 6, lines 5-7. Additionally, Applicants amend claims 1, 17, and 21-24 to clarify that the application of tension to the proximal end of the deflection member will cause the deflection member to be flexed longitudinally relative to said elongate member. Support for this amendment can be found throughout the specification, at least at page 18, lines 3-5.

These amendments are presented in order to clarify Applicant's contribution to the art and remove certain recitations (e.g., the energy source) that are not believed to be pertinent to patentability.

Applicants amend claim 3 to include the recitation of an energy source, which was previously recited in claim 1.

Applicants cancel claim 5.

Applicants amend claim 9 to clarify the location of the tapered narrow section, as per the Examiner's suggestion.

Applicants add new claim 25 which recites a maneuverable apparatus for remotely applying therapeutic energy to biological tissue comprising a flexible tubular elongate member

and a tubular deflection member coaxial with the elongate member having a partially cut-away distal end region with a *helical* shape. Application of tension to the proximal end of the deflection member will cause the deflection member to be both *flexed longitudinally* and *rotated relative to a longitudinal axis*, thereby causing the distal end of the elongate member to bend in a non-planar direction. Support for new claim 25 can be found within the pending claims, as well as throughout the specification at least at page 30, lines 16-27.

No new matter is added.

Claims 1, 3-4, 6-9, and 11-25 are now pending.

Rejections under 35 U.S.C. § 112

The Examiner rejects claims 1, 3-9, and 11-24 pursuant to 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. Specifically, with respect to claims 1, 17, and 21-24, the Examiner states that the recitation “said lumen of the deflection member” lacks antecedent basis, and with respect to claim 9, the Examiner states that the term “it’s” in claim 9 is unclear and lacks antecedent basis.

The Examiner is thanked for noting the inconsistencies and informalities in the claims. Applicants have amended claims 1, 9, 17, and 21-24 to provide the proper antecedent basis.

Rejections under 35 U.S.C. § 103(a)

Rejections of Claims 1, 3-9, 11, 12, 15, 16, and 23 as being unpatentable over Kittrell in view of Heaven

Claims 1, 3-9, 11, 12, 15, 16, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,104,392 to Kittrell et al. in view of U.S. Patent No. 5,306,245 to Heaven. In particular, and in response to Applicants’ arguments, the Examiner argues:

Applicant has argued that the unique form of the deflection member of the instant invention enables complex deformations to be achieved. While this is noted by the examiner, the claims

must still read over the art of record. The claims at bar are still very broad, not even reciting any sort of connection between the deflection member and the elongate member. And the examiner must note that the element 6 in Figure 1 of Heaven completely fulfills the requirement for a "partially cut-away distal end region" and the instant "comprising-type" claims do not preclude other structures such as the pull wire.

In response, Applicants have amended the claims to clarify Applicant's contribution to the art. In particular, Applicants have amended the claims to clarify the *connection* between the deflection member and the elongate member and their relationship. Thus, the amended claims recite that the deflection member is *coaxial* with the elongate member such that when *tension* is applied to the proximal end of the deflection member, the deflection member *flexes longitudinally*, thereby inducing the distal end of the elongate member to bend.

At the outset, Applicants reiterate their position that one having skill in the art would have no motivation to combine Kittrell and Heaven for the reasons recited in their prior response. Further, the amended claims distinguish over Kittrell and Heaven because neither reference teaches a device wherein the application of tension to the proximal end of the deflection member will cause the deflection member to be flexed longitudinally relative to the elongate member.

As noted by the Examiner, Kittrell teaches a device that does not recite a maneuverable apparatus having a deflection member with a partially cut-away distal end region. Heaven does not remedy the deficiencies of Kittrell. Heaven teaches a tubular member having a cut-out *on one side* and a pull wire *on the opposite side* of the cut-out. Nowhere does Heaven teach a deflection member that is *coaxial* with the elongate member, as required by Applicants' claims. Rather, Heaven teaches a pull wire that is located *on the side of* the tubular member. Further, the pull wire and the cut out of Heaven work *in tandem* to maneuver the tubular member. That is, when tension is applied to the pull wire, the cut out facilitates bending of the tubular member. Thus, nowhere does the application of tension to the proximal end of Applicant's the deflection member cause the *deflection member* to be flexed longitudinally relative to the *elongate member*,

as required by Applicants' claims, but rather application of tension to the pull wire causes the *tubular member* to flex *relative to the cut out*.

Because Kittrell in view of Heaven does not teach or suggest the recitations of claims 1, 3-4, 6-9, 11, 12, 15, 16, and 23, and one having skill in the art would have no motivation to combine Kittrell with Heaven, claims 1, 3-4, 6-9, 11, 12, 15, 16, and 23 represent allowable subject matter, and allowance thereof is respectfully requested.

New Claim 25 is also patentable

None of the cited references teach or even suggest a maneuverable apparatus having a flexible tubular elongate member and a *tubular deflection member* with a partially cut-away distal end region *having a helical shape* where application of tension to the proximal end of the deflection member will cause the deflection member to be *flexed* and *rotated* relative to a longitudinal axis thereby causing the distal end of the elongate member to bend in a non-planar direction, as required by claim 25. Accordingly, claims 25 represents allowable subject matter, and allowance thereof is respectfully requested.

Rejections of Claims 13 and 14 as being unpatentable over Kittrell in view of Heaven, and further in view of Vassiliadis

Claims 13 and 14 stand rejected over the same references above, and further in view of U.S. Patent No. 5,129,895 to Vassiliadis et al. In addition to the above, Applicants reiterate the position that neither Kittrell nor Heaven teach or suggest a layer of reflective material affixed to the distal end region of the elongate member. Vassiliadis does not remedy the deficiencies of Kittrell and Heaven because Vassiliadis teaches a reflective material that is located in an entirely different place, and has an entirely different purpose than that recited by Applicants. Further, Applicants reiterate that one having skill in the art would have no motivation to combine Kittrell, Heaven, and Vassiliadis because Vassiliadis is directed to an entirely different surgical procedure than Kittrell and Heaven. In particular, Vassiliadis is directed towards *performing a sclerostomy* (forming a small hole in the sclera of an eye) as a treatment of glaucoma, and Kittrell and Heaven are directed towards intravascular laser treatment of atherosclerotic disease or conventional arthroscopic or laparoscopic procedures.

Thus, because Kittrell, Heaven, and Vassiliadis do not teach or suggest the recitations of claims 13 and 14, and one having skill in the art would have no motivation to combine Kittrell, Heaven, and Vassiliadis, claims 13 and 14 represent allowable subject matter, and allowance thereof is respectfully requested.

Rejections of Claims 22 and 24 as being unpatentable over Kittrell in view of Heaven, and further in view of Isner

Claims 22 and 24 stand rejected over Kittrell in view of Heaven, and further in view of U.S. Patent No. 4,985,028 to Isner et al. In addition to the above, Applicants reiterate the position that neither Kittrell nor Heaven teach or suggest positioning a slidable conductor through the lumen of the elongate member proximate to the atrial tissue site. The disclosure of Isner does not remedy the deficiencies of Kittrell and Heaven because nowhere does Isner teach or suggest any type of slidable conductor. Further, Applicants reiterate that one having skill in the art would have no motivation to combine Kittrell, Heaven, and Isner because the teachings of Isner are the exact opposite as those of Kittrell and Heaven. In particular, while the teachings of both Kittrell and Heaven are directed towards *movement* of the device, Isner teaches sliding the distal end of a catheter into a patient's heart, and moving a fixation wire proximally to the distal end of the catheter to *prevent movement* of the catheter during use and provide rigidity to the catheter to maintain the portion of the distal tip during use.

Thus, because Kittrell, Heaven, and Isner do not teach or suggest the recitations of claims 22 and 24, and one having skill in the art would have no motivation to combine Kittrell, Heaven, and Isner, claims 22 and 24 represent allowable subject matter, and allowance thereof is respectfully requested.

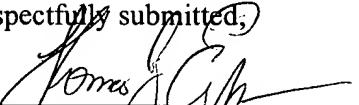
Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. The Examiner is kindly requested to telephone the undersigned representative in the event that the amendments do not place this case in condition for allowance or if a telephone interview can otherwise expedite the prosecution of this application.

Dated: October 28, 2005

Respectfully submitted,

By


Thomas J. Engellenner
Registration No.: 28,711
NUTTER MCCLENNEN & FISH LLP
World Trade Center West
155 Seaport Boulevard
Boston, Massachusetts 02210-2604
(617) 439-2000
(617) 310-9000 (Fax)
Attorneys/Agents for Applicant

1465747.1